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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/028,419 | 12/21/2001 | Joseph Vanniasinkam | M-9340 US | 3557 |
| 22852 | 7590 | 06/14/2005 | EXAMINER | KIANNI, KAVEH C |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | ART UNIT | PAPER NUMBER |
| | | | 2883 | |

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|--|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/028,419 | VANNIASINKAM ET AL.  |
| | Examiner | Art Unit |
| | Kianni C. Kaveh | 2883 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 May 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 and 23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-15 and 23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 May 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

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- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. 15.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

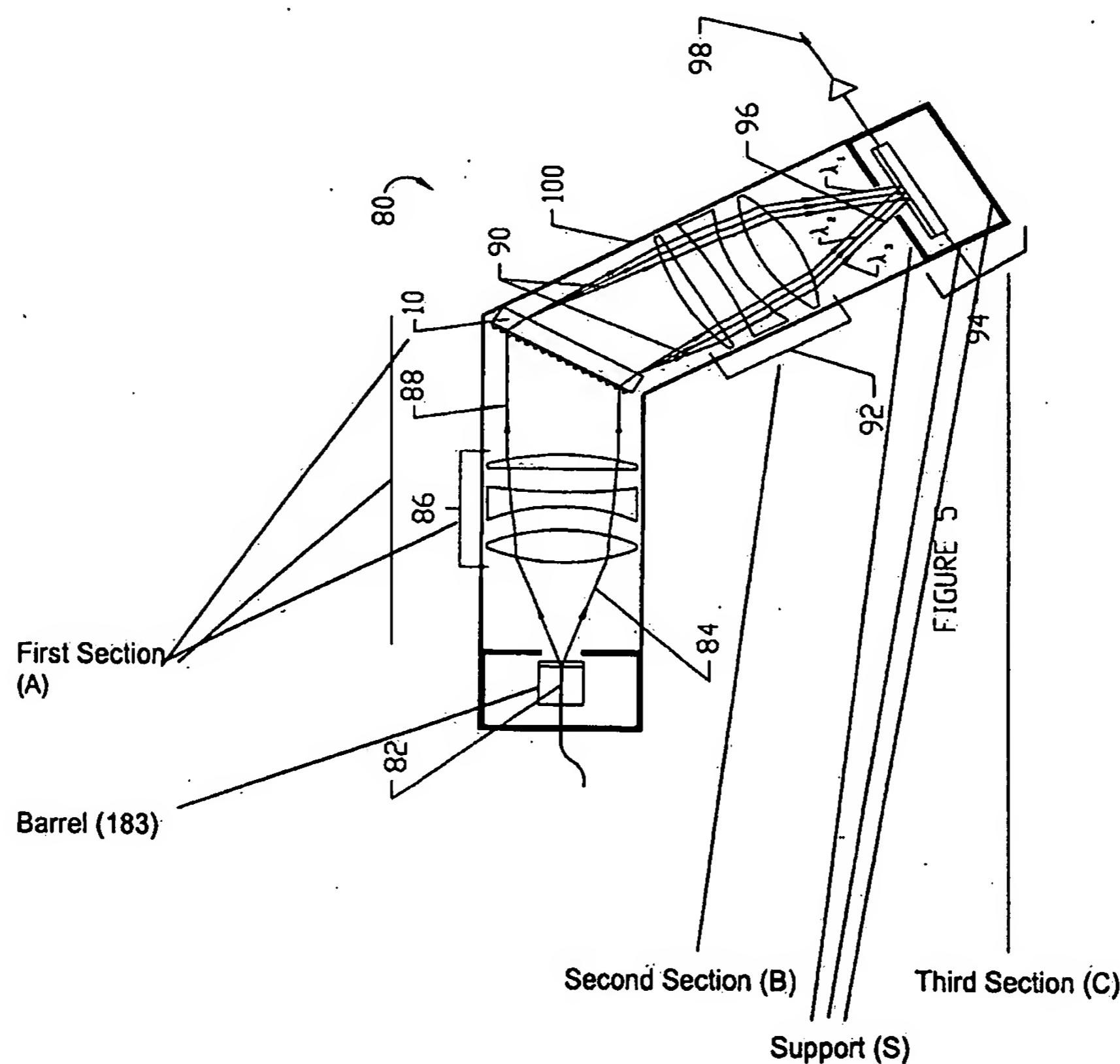
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer (US 6583934).

U.S. Patent Jun. 24, 2003 Sheet 5 of 34 US 6,583,934 B2



Regarding claims 1-6 and 12-13, Kramer teaches a monitoring device (shown in at least figure 5, see above figure), comprising:

a first section A capable of receiving a WDM beam (see fig 5, item first section A containing lens assembly 86 and grating 10 for receives WDM beam via fiber 82; see also col. 13, lines 48-52),

a diffraction grating 10 integrally formed with the first section A (shown in fig. 5, item 10 receives WDM beam 88 being directed onto the internal surface of the diffraction grating 10 (shown in fig. 5, item 10 provides angularly separated beams $\lambda 1..\lambda 3$ on the external surface of the diffraction grating 10; a second section B (see second section for collimating and focusing diffracted beam 90) integrally formed with the first section A; and a third section C integrally formed with the second section B, the third section C positioned relative to the first section C to receive spatially separated light beams 90 of a selected diffraction order $\lambda 1..\lambda 3$ from the diffraction grating 10 (shown in fig. 5, item 3 receives spatially separated light beams of a selected diffraction order $\lambda 1..\lambda 3$ from the diffraction grating 10);

wherein the first section A, the second section B, the third section C, and the diffraction grating 10 are integrally formed in a single piece (see fig. 5, wherein the first section A, the second section B, and the third section C are integrally formed in a single piece through housing 100) using a molding process (this limitation has not given a patentable weight by the examiner because as stated in the MPEM 2144.04, such as in section V.B does not warrant patentability based on integrally forming a device, such as by molding process; further the presence of process limitations on product claims, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to the product *In re Stephens*, 145 USPQ 656 (CCPA 1965). See also 2113 Product-by-Process Claims: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The

patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product)

Kramer further teaches wherein the reflective surface is coated external to the first section with thin/reflective/gold film to enhance internal reflection of the WDM beam (see col. 10, line 66-col. 11, line 15).

However, Kramer, in the first embodiment, does not specifically teach wherein the above monitor in the preamble is a demultiplexer; a reflective surface coated with a silver/reflective film, integrally formed on the first section that directs the WDM beam received into the first section onto a bottom surface of the diffraction gating; wherein the third section includes a focusing lens that has support around it. Nevertheless, Kramer's monitor device diffracts WDM beam into individual wavelengths and in second embodiment Kramer teaches a reflective surface integrally formed on the first section that directs the WDM beam received into the first section onto a bottom surface of the diffraction gating (see fig. 18 and 19, item reflector 15 and grating 15') that the

reflecting surface is coated with a reflecting coating such as gold or aluminum (see col. 9, line 66-col. 11, line 5); Kramer further states that appropriate lens assembly combinations will be apparent to those skilled in the art (see col. 16, 3rd parag.). Thus, It is well known to those of ordinary skill in the art that separation of multiplexed light into separate wavelengths known as demultiplexor, and it would have been obvious to a person of ordinary skill in the art when the invention was made to combine different embodiments of Kramer's teachings such as by replacing the grating 10 with that of double grating 250 in which item 15 functions as a reflector and use a silver coating rather than a gold or aluminum, and further, as a matter of design choice, place a lens around the support section S aperture (see above figure) of third section in order to construct a demultiplexing system that includes the above limitations, and since such coating would have essentially the same functional effect and since such demultiplexing system would provide a surface relief/aligner transmission grating with improved durability with a highly diffraction efficiency performance (col. 2, lines 21-24 and 57-62).

- The statements advanced in claims 1-6 and 12-13, above, as to the applicability and disclosure of Kramer are incorporated herein as follows:

Regarding claims 7-11 and 14-15, Kramer further teachers wherein the first section includes an integrally formed collimating lens 86 integrally formed into the single piece, the integrally formed collimating lens 86 collimating the WDM beam received from an optical fiber (shown fig. 6, item 86); further including a barrel (see fig. 5 also

10A, the barrel 183 containing fiber) integrally formed with the first section A, the barrel capable of receiving an optical fiber and aligning the optical fiber with the collimating lens 86 (see at least fig. 5, item barrel containing/receives fiber and aligns it with the collimating lens 86); a post integrally formed into the single piece with the first section A, the post capable of receiving a barrel (shown in above figure 5 and 10a, item post in front of the barrel 183 receiving the barrel/ferrule 183); wherein the barrel includes a fiber access and a fiber stop (shown in figure 5 and 10a in which the fiber entering the ferrule/barrel 183 stopped at the aperture portion of the barrel); wherein a detector array 94 can be mounted on the support S so that the spatially separated beams $\lambda 1..\lambda 3$ are directed onto individual detectors of the detector array (see fig. 5 item photodetector array 94); wherein optical fibers are arranged to receive individual ones of the spatially separated beams (shown in at least fig. 10a, item receiving fibers in the array of fibers 186).

Claims 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over combination of Kramer and Ibsen (US 20030067645).

Regarding claims 23, Kramer teaches a monitoring device (shown in at least figure 5, see above), comprising:

means for separating an input light beam 88 into constituent parts $\lambda 1..\lambda 3$ with a integrally formed component 10 (see fig. 5, above, first section S through grating 10 separates input beam 88 into $\lambda 1..\lambda 3$);

means 94 for detecting the constituent parts $\lambda 1..\lambda 3$ from the integrally formed single

piece component 10;

means 100 for aligning the means for separating (see first section S) with the means for detecting 94 (see the housing 100, inherently, aligns the first section S--for separating the input light beam 88 into constituent parts $\lambda 1..\lambda 3$ —with that of the detector 94; note that this alignment scheme is analogous to the applicant's aligning means—i.e., as stated in the specification parag. 0034 with regard to alignment of the elements/means in figure 2). Regarding Kramer's teachings of demultiplexer the arguments presented in rejection of claim 1 is analogous in rejection of claim 23.

However, Kramer does not specifically teach wherein the above integrally formed component is a molded single piece component. Although the examiner does not give patentable weight to molded single piece based on the arguments that were presented in rejection of claim 1, nevertheless, this limitation is more specifically taught by Ibsen et al. (see parag. 0153). Thus, it would have been obvious to a person of ordinary skill in the art when the invention was made to modify Kramer's integrated component 10 and replace it with that of Ibsen et al's molded grating device 214 in order to produce a WDM that include the above limitations since such demultiplexing system would provide a surface relief/aligner transmission grating with improved durability with a highly diffraction efficiency performance (col. 2, lines 21-24 and 57-62)

Response to Arguments and Amendment

Applicant's argument filed on 5/2/05 have been fully considered but they are not persuasive.

Regarding applicant's assertion that Kramer does not teach wherein the first section, the second section, the third section, and the diffraction grating are integrally formed in a single piece using a molding process the examiner responds that as shown in figure 5 (*and as illustrated by the examiner in the previous office action*), Kramer teaches a third section C integrally formed with the second section C and the first section A; the first, second and the third sections A-C are integrally formed in a single piece as shown in figure 5, and further, Kramer teaches a means (section C) for separating an input light beam 88 into constituent parts λ1..λ3 with an integrally formed single piece component 10. Thus, various components in the first, second and third sections A-C elements such as lens 86 and barrel 183 are integrally formed into a single piece as shown in figure 5. Further, as stated in the telephone interview with Mr. Edwards on June 05, 05 even with insertion of a suggested limitation 'wherein the multiplexer substantially aligned upon formation' does not place the application in the condition of allowance since with the presence of new references in a new search by the examiner showed that the molding process in WDM is well known in the art in which at least one of the references discussed by the examiner teaches all limitations of the base claim including alignment by molding process. Also the MPEM section 2144.04,

V.B was mentioned by the examiner stating that integrally forming a device, such as by molding, does not warrant granting of patentability based on integration process. Thus, it was agreed that the applicant to review the prior art and appropriately narrow the scope of the claims with structural limitations in order to allow the application.

Citation of Relevant Prior Art

Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In accordance with MPEP 707.05 the following references are pertinent in rejection of this application since they provide substantially the same information disclosure as this patent does. These references are:

Ibsen et al. 20030067645 teaches WDM through molding process

Rose et al. 20020154855 teaches WDM through molding process

Bischel et al. 5835458 teaches WDM through molding process

These references are cited herein to show the relevance of the apparatus/methods taught within these references as prior art.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Cyrus Kianni whose telephone number is (571) 272-2417.

The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font, can be reached at (571) 272-2415.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2883

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or:

Hand delivered responses should be brought to Crystal Plaza 4, 2021 South Clark Place, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956.



K. Cyrus Kianni
Patent Examiner
Group Art Unit 2883

June 7, 2005